



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,009	09/29/2003	Satoru Saito	121036-062	2388
35684 7590 03/07/2007 BUTZEL LONG 350 SOUTH MAIN STREET SUITE 300 ANN ARBOR, MI 48104			EXAMINER KATAKAM, SUDHAKAR	
			ART UNIT	PAPER NUMBER
			1621	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		03/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/674,009	Applicant(s) SAITO ET AL.	
	Examiner Sudhakar Katakam	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

1. Receipt of Applicant's Remarks and Arguments filed on Dec 26, 2006 is acknowledged. The arguments were not found persuasive and as such, the following rejection has been maintained.

Claims 1-28 are pending. No Amendments to the claims have been made.

Claims 1-28 remain rejected.

Response to Arguments

2. Applicant's arguments filed on 12th December 2006 have been fully considered but they are not persuasive.

Claims 1-12, 17-20 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Enokida et al (US 5,969,066) in view of Worm et al (US 6,734,254) for the reasons of record.

The thrust of applicants' arguments is that Enokida et al fails to teach applicants' monomer (d), teachings of Worm et al, provide no motivation for including monomer (d) into the fluoroelastomer of Enokida et al, and hence there is no suggestion in either Enokida et al or Worm et al that the inclusion of monomer (c) improves TR70 values, particularly in combination with monomer (d).

The examiner does not find these arguments persuasive. Applicants pointed to the monomer (d) is not being taught by Enokida et al. Please note the difference between instant claims and Enokida et al is that instant claims used the $\text{CF}_2=\text{CFO}[\text{CF}_2\text{CF}(\text{CF}_3)\text{O}]_n\text{CF}_3$ as a monomer, where as **Enokida et al** used

Art Unit: 1621

$\text{CF}_2=\text{CFOCF}_2\text{CF}_2\text{Br}$. With regard to the monomer, **Worm et al** teaches the advantages of using $\text{CF}_2=\text{CFO}[\text{CF}_2\text{CF}(\text{CF}_3)\text{O}]_n\text{CF}_3$ for fluoroplastics, which reads the applicants monomer (d). So, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made, to combine the **Enokida et al** and **Worm et al** teachings to make instant claims composition, with a reasonable expectation of success.

Applicants show how each cited reference differ from the instant invention, but the obviousness test under 35 U.S.C. 103 is whether the invention would have been obvious in view of the prior art taken as a whole. In re Metcalf et al. 157 U.S.P.Q. 423.

Applicants allege unexpected beneficial results to be obtained by the use of their invention, e.g., certain TR values, but have not shown this in a side-by-side comparison with closest prior art.

Claims 13-16, and 21-28 are also again rejected under 35 U.S.C. 103(a) as being unpatentable over Enokida et al (US 5,969,066) for the reasons of record. The applicants' arguments have been given due consideration but are found non-persuasive.

The comments given above are applicable here as well. Enokida et al teaches the method of making fluoroelastomer and its cross-linkable composition. The kneaded product was subjected to press vulcanization. The scope of the generic composition prepared by Enokida et al overlaps the scope of the generic composition found in the instant claims 13-16 and 21-28. The reference does not use the compound $\text{CF}_2=\text{CFO}[\text{CF}_2\text{CF}(\text{CF}_3)\text{O}]_n\text{CF}_3$, instead they used $\text{CF}_2=\text{CFOCF}_2\text{CF}_2\text{Br}$, but it would have

Art Unit: 1621

been obvious to a person having ordinary skill in the art to further to modify the composition with the reasonable expectation of success, since the substitution of Br with F does not make difference in making a elastomer.

It would have been prima facie obvious at the time the invention was made to one of ordinary skill in the art to start with the teachings of the cited references to make applicants' composition using their reactants to expect to produce corresponding TR values.

3. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136 (a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no even, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

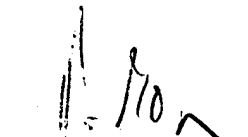
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sudhakar Katakam whose telephone number is 571-272-9929. The examiner can normally be reached on M-F 8:30 AM - 5:00 PM.

Art Unit: 1621

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


S. Katakam 2/28/07


PETER O'SULLIVAN
PRIMARY EXAMINER
GROUP 1200